UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/630,130	07/29/2003	David C. Steere	50037.187US01	6703

27488   7590   02/20/2008
MERCHANT & GOULD (MICROSOFT)
P.O. BOX 2903
MINNEAPOLIS, MN 55402-0903

EXAMINER
REYES, MARIELA D

ART UNIT	PAPER NUMBER
2167	

MAIL DATE	DELIVERY MODE
02/20/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
Office Action Summary	10/630,130	STEERE ET AL.
	Examiner	Art Unit	
	Mariela D. Reyes	2167	

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *06 November 2007*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *18-37* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *18-37* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/ are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

        1.☐ Certified copies of the priority documents have been received.

        2.☐ Certified copies of the priority documents have been received in Application No. _____.

        3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set

forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this

application is eligible for continued examination under 37 CFR 1.114, and the fee set

forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action

has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on

November 6th, 2007 has been entered.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

According to the Interim Guidelines presented in the MPEP 2106.1

When nonfunctional descriptive material is recorded on some computer-readable medium, in a computer or on an electromagnetic carrier signal, it is not statutory since no requisite functionality is present to satisfy the practical application requirement. Merely claiming nonfunctional descriptive material, i.e., abstract ideas, stored in a computer-readable medium, in a computer, on an electromagnetic carrier signal does not make it statutory. See Diehr, 450 U.S. at 185-86, 209 USPQ at 8 (noting that the claims for an algorithm in Benson were unpatentable as abstract ideas because "[t]he sole practical application of the algorithm was in connection with the programming of a general purpose computer."). Such a result would exalt form over substance. In re Sarkar, 588 F.2d 1330, 1333, 200 USPQ 132, 137 (CCPA 1978) ("[E]ach invention must be evaluated as claimed; yet semantogenic considerations preclude a determination based solely on words appearing in the claims. In the final analysis under § 101, the claimed invention, as a whole, must be evaluated for what it is.") (quoted with approval in Abele, 684 F.2d at 907, 214 USPQ at 687). See also In re Johnson, 589 F.2d 1070, 1077, 200 USPQ 199, 206 (CCPA 1978) ("form of the claim is often an exercise in drafting"). Thus, nonstatutory music is not a computer component and it does not become statutory by merely recording it on a compact disk. Protection for this type of work is provided under the copyright law.

Claims 26-30 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The above-mentioned claims recite a computer readable storage medium. This computer readable storage medium is defined in applicant's specification Page 4 Lines 21-30 as being embodied by data in a modulated data signal, such as a carrier wave. Carrier waves do not fall under one of the four categories of patentability therefore are not patentable.

For the following 35 U.S.C rejections refer to MPEP 2106.1 an excerpt of which is presented here:

I. FUNCTIONAL DESCRIPTIVE MATERIAL: "DATA STRUCTURES" REPRESENTING DESCRIPTIVE MATERIAL *PER SE* OR COMPUTER PROGRAMS REPRESENTING COMPUTER LISTINGS *PER SE*

Data structures not claimed as embodied in computer-readable media are descriptive material *per se* and are not statutory because they are not capable of causing functional change in the computer. See, e.g., *Warmerdam*, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure *per se* held nonstatutory). Such claimed data structures do not define any structural and functional interrelationships between the data structure and other claimed aspects of the invention which permit the data structure's functionality to be realized. In contrast, a claimed computer-readable medium encoded with a data structure defines structural and functional interrelationships between the data structure and the computer software and hardware components which permit the data structure's functionality to be realized, and is thus statutory.

Similarly, computer programs claimed as computer listings *per se*, i.e., the descriptions or expressions of the programs, are not physical "things." They are neither computer components nor statutory processes, as they are not "acts" being performed. Such claimed computer programs do not define any structural and functional interrelationships between the computer program and other claimed elements of a computer which permit the computer program's functionality to be realized. In contrast, a claimed computer-readable medium encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer program and the rest of the computer which permit the computer program's functionality to be realized, and is thus statutory. See *Lowry*, 32 F.3d at 1583-84, 32 USPQ2d at 1035. Accordingly, it is important to distinguish claims that define descriptive material *per se* from claims that define statutory inventions.

Claims 31-37 are rejected under 35 U.S.C. 101 because the claimed invention is

directed to non-statutory subject matter. The above-mentioned claims are non-statutory

because they are software per se; the claims recite a system lacking hardware therefore

the system is analyzed as non-functional descriptive material.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

Claims 18-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Eastep (US Patent 5,566,328) in view of Gwertzman et al (US Patent 6,189,000).

With respect to independent claim 1:

Eastep teaches:

A computer-implemented method for dynamically resolving a pathname in

the context of a user, the method comprising:

Receiving a pathname from a requesting component wherein the pathname

includes a variable associated with a user context; (Column 6 Lines 18-20,

discloses receiving a file handle that includes a link ID)

Identifying the variable in the pathname that is associated with the user

context; (Column 6 Lines 18-20 and 27-28, discloses that the Link ID is identified to be

used in resolving the pathname)

Mapping the variable associated with the user context to a value; (Column 6

Lines 27-28, discloses that the directory table is searched to find a corresponding value

to the Link ID)

Resolving the pathname to a handle for an object associated with the

value; (Column 3 Lines 60-61)

Returning the handle for the object to the requesting component for access

to the object. (Column 3 Lines 60-61, discloses that the new pathname will be used to

access the file)

Eastep does not appear to explicitly disclose **the pathname includes a variable**

that identifies at least one member of a group comprising: a current user of the

requesting component, and a location of the requesting component within a

network and modifying the pathname by including the value in the pathname.

Gwertzman teaches **the pathname includes a variable that identifies at least**

one member of a group comprising: a current user of the requesting component,

and a location of the requesting component within a network; (Column 2 Lines 20-

27, discloses a logical name that forms part of a pathname. This logical name will

include the location and the information of a user and will be appended to a pathname)

and modifying the pathname by including the value in the pathname. (Column 2

Lines 20-32, discloses adding the logical name to the pathname for easier reference to

a given application)

It would have been obvious for one of ordinary skill in the art at the time of the

invention to combine the teachings of the cited references to implement **the pathname**

includes a variable that identifies at least one member of a group comprising: a

current user of the requesting component, and a location of the requesting

component within a network and modifying the pathname by including the value

in the pathname because this would make an administrator's job easier because the

administrator will not have to be aware of the user information because it would be

extracted from a database.

With respect to claim 21:

Eastep teaches:

The value is a factor in resolving the pathname to the handle for the object.

(Column 6 Lines 33-36, discloses that the Link ID is used to access a stored value that

then will be appended to the pathname to resolve it)

With respect to claim 22:

Eastep teaches:

The variable associated with the user context includes a prefix that

indicates that the variable is associated with the user context. (Column 6 Lines 1-

12, discloses that the Link ID is associated with a stored value related to the stored file)

Eastep does not appear to explicitly disclose a **variable that identifies at least one member of a group comprising: a current user of the requesting component, and a location of the requesting component within a network.**

Gwertzman teaches **a variable that identifies at least one member of a group comprising: a current user of the requesting component, and a location of the requesting component within a network.** (Column 2 Lines 20-27, discloses a logical name that forms part of a pathname. This logical name will include the location and the information of a user and will be appended to a pathname)

With respect to claim 23:

Eastep teaches:

Modifying the pathname includes replacing the variable associated with the user context with the value. (Column 6 Lines 33-36, discloses that the value related to the Link ID will be appended to the pathname)

With respect to claim 24:

Eastep teaches:

Mapping the variable includes accessing an updatable data store and mapping the variable to the value associated with the data store. (Column 6 Lines 27-28, discloses that the Link ID value will be compared against a directory table to extract the value to help resolve the pathname)

With respect to claim 25:

Eastep teaches:

The data store includes a plurality of mappings, wherein each mapping is associated with a user, wherein at least one of the mappings is different than the other mappings to implicate a different object than the other mappings. (Column 3 Lines 44-57, discloses that each Link ID will be associated to a unique value stored in the directory table)

With respect to independent claim 26:

Eastep teaches:

A computer-readable storage medium having computer-executable instructions for dynamically resolving a pathname in the context of a user, the instructions comprising:

Receiving a pathname from a requesting component wherein the pathname includes a prefix and a variable associated with a user of the requesting component; (Column 6 Lines 18-20, discloses receiving a file handle that includes a link ID)

Identifying the variable in the pathname that is associated with the user context, wherein the variable is identified from the prefix; (Column 6 Lines 18-20 and 27-28, discloses that the Link ID is identified to be used in resolving the pathname)

Mapping the variable associated with the user context to a value that implicates the current user of the requesting component; (Column 6 Lines 27-28,

discloses that the directory table is searched to find a corresponding value to the Link

ID)

Resolving the pathname to a handle for an object associated with the

value; and (Column 3 Lines 60-61)

Returning the handle for the object to the requesting component for access

to the object. (Column 3 Lines 60-61, discloses that the new pathname will be used to

access the file)

Eastep does not appear to explicitly disclose **a variable that identifies the user;**

modifying the pathname by replacing the variable associated with the user

context with the value.

Gwertzman teaches **a variable that identifies the user;** (Column 2 Lines 20-27,

discloses a logical name that forms part of a pathname. This logical name will include

the location and the information of a user and will be appended to a pathname)

modifying the pathname by replacing the variable associated with the user

context with the value. (Column 2 Lines 20-32, discloses adding the logical name to

the pathname for easier reference to a given application)

It would have been obvious for one of ordinary skill in the art at the time of the

invention to combine the teachings of the cited references to implement **a variable that**

identifies the user; modifying the pathname by replacing the variable associated

with the user context with the value because this would make an administrator's job

easier because the administrator will not have to be aware of the user information

because it would be extracted from a database.

With respect to claim 27:

Eastep teaches:

The value implicates a location of the requesting component with a network. (Column 5 Lines 62-63, discloses that the Link ID is associated with the location of the object)

With respect to claim 28:

Eastep teaches:

The value is a factor in resolving the pathname to the handle for the object. (Column 6 Lines 33-36, discloses that the Link ID is used to access a stored value that then will be appended to the pathname to resolve it)

With respect to claim 29:

Eastep teaches:

Mapping the variable includes accessing an updatable data store and mapping the variable to the value associated with the data store. (Column 6 Lines 27-28, discloses that the Link ID value will be compared against a directory table to extract the value to help resolve the pathname)

With respect to claim 30:

Eastep teaches:

The data store includes a plurality of mappings, wherein each mapping is associated with a user, wherein at least one of the mappings is different than the other mappings to implicate a different object than the other mappings. (Column 3 Lines 44-57, discloses that each Link ID will be associated to a unique value stored in the directory table)

With respect to independent claim 31:

Eastep teaches:

A system for dynamically resolving a pathname in the context of a user, the system comprising:

A requesting component associated with a user mode, wherein the requesting component is configured to send a pathname, receive an object handle, and obtain an object associated with the object handle, wherein the pathname includes a variable associated with a user context; (Column 6 Lines 18-20, discloses receiving a file handle that includes a link ID)

A variable identifier component associated with the user mode, wherein the variable identifier component is configured to identify the variable associated with the user context; (Column 6 Lines 18-20 and 27-28, discloses that the Link ID is identified to be used in resolving the pathname)

A data store component associated with a kernel mode, wherein the data store component includes mappings that map the variable associated with the

user context to a value; and (Column 6 Lines 27-28, discloses that the directory table is searched to find a corresponding value to the Link ID)

A pathname engine component associated with the kernel mode, wherein the pathname engine component is configured to receive the pathname from the requesting component, request evaluation of the pathname from the variable identifier component, receive an identified variable from the variable identifier component, access the data store component to receive a value associated with the identified variable, and return an object handle to the requesting component that is based on the modified pathname that includes the value. (Column 3 Lines 60-61, discloses that the new pathname will be used to access the file)

Eastep does not appear to explicitly disclose **the pathname includes a variable that identifies at least one member of a group comprising: a current user of the requesting component, and a location of the requesting component within a network; and obtain a modified pathname that includes the value.**

Gwertzman teaches **the pathname includes a variable that identifies at least one member of a group comprising: a current user of the requesting component, and a location of the requesting component within a network;** (Column 2 Lines 20-27, discloses a logical name that forms part of a pathname. This logical name will include the location and the information of a user and will be appended to a pathname) **and obtain a modified pathname that includes the value.** (Column 2 Lines 20-32, discloses adding the logical name to the pathname for easier reference to a given application)

It would have been obvious for one of ordinary skill in the art at the time of the invention to combine the teachings of the cited references to implement **the pathname includes a variable that identifies at least one member of a group comprising: a current user of the requesting component, and a location of the requesting component within a network; and obtain a modified pathname that includes the value** because this would make an administrator's job easier because the administrator will not have to be aware of the user information because it would be extracted from a database.

With respect to claim 21:

Eastep teaches:

The value is a factor in resolving the pathname to the handle for the object. (Column 6 Lines 33-36, discloses that the Link ID is used to access a stored value that then will be appended to the pathname to resolve it)

With respect to claim 22:

Eastep teaches:

The variable associated with the user context includes a prefix that indicates that the variable is associated with the user context. (Column 6 Lines 1-12, discloses that the Link ID is associated with a stored value related to the stored file)

Eastep does not appear to explicitly disclose a **variable that identifies at least one member of a group comprising: a current user of the requesting component, and a location of the requesting component within a network.**

Gwertzman teaches **a variable that identifies at least one member of a group comprising: a current user of the requesting component, and a location of the requesting component within a network.** (Column 2 Lines 20-27, discloses a logical name that forms part of a pathname. This logical name will include the location and the information of a user and will be appended to a pathname)

With respect to claim 23:

Eastep teaches:

Modifying the pathname includes replacing the variable associated with the user context with the value. (Column 6 Lines 33-36, discloses that the value related to the Link ID will be appended to the pathname)

With respect to claim 24:

Eastep teaches:

Mapping the variable includes accessing an updatable data store and mapping the variable to the value associated with the data store. (Column 6 Lines 27-28, discloses that the Link ID value will be compared against a directory table to extract the value to help resolve the pathname)

Response to Arguments

Claim Objections

The instant amendments to the objected claims overcome the claim objections,

therefore the objections have been removed.

Claim Rejection 35 USC 101

Applicant argues that the rejection is incorrect because **"the claims recite a**

computer readable storage medium". Examiner respectfully disagrees. Applicant's

specification (Page 4) equals the computing device (Element 100) in Fig.1 with the

computer readable medium and on that same page Lines 21-29 the same computing

device is also being defined in terms of carrier waves. Therefore the computer readable

storage medium is still considered non-statutory.

Claim Rejections 35 USC 102

Applicant's arguments with respect to the 35 USC 102 rejections have been

considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Mariela D. Reyes whose telephone number is (571)

270-1006. The examiner can normally be reached on M - F 7:30- 5:00 East time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Cottingham can be reached on (571) 272-7079. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MR Feb. 12, 08
MR

DL

DEBBIE LE
PRIMARY EXAMINER
2/13/08